

REMARKS

Acknowledgement of Applicant's claim to priority and submission of the priority document in April 2004 is respectfully requested.

Claims 1-20 were rejected under 35 U.S.C. 112, first paragraph as failing to comply with the enabling requirement based on "the teaching in the prior art, Mulye (U.S. 6,436,430)". This rejection is respectfully traversed.

There are a number of errors in attempting to apply the *Wands* factors including, *inter alia*, the failure to note that both of the commercial products in Table 2 contain a mixture of mono- and diesters, as explicitly stated therein. There is, however, a much more fundamental deficiency in this rejection which relates to the interpretation of the Mulye patent. More particularly, there is nothing in this reference which states that "when [the] carrier system contained propylene glycol ester having greater percentage of diester in the mixture with monoester, the system lacks uniformity and is not suitable for any commercial use" (emphasis added). There is no requirement under law that a composition be "commercially" useful but only that it be useful and even if there was such a requirement, the reference does not negate commercial utility. The passages in column 15 and 16 to which the Office Action refers is based on comparative examples 1 and 2 which deal with observations of the compositions initially and after one or two weeks. Since the comparative examples were clearly commercially acceptable for some period of time up to one or two weeks, there is no question of commercial utility. The present application clearly discloses how to make and use the claimed composition in such a way to enable one skilled in the art. Accordingly, withdrawal of the rejection under §112 is respectfully requested.

The claims were also rejected under 35 U.S.C. 103 over the Mulye PCT publication (which appears to correspond to the Mulye patent). It is respectfully submitted that this rejection is not tenable and should be withdrawn.

Mulye teaches one skilled in the art that a propylene glycol ester of a 6 to 18 carbon atom fatty acid in which the monoester is at least 60% and the diester is no greater than 40% should be used. The composition of the present invention differs from this reference in two respects, namely that the fatty acid have from 8 to 10 carbon atoms and the monoester is less than 60 mole percent of the monoester/diester mixture. As the Examiner has pointed out, one skilled in the art would not believe such a composition was storage stable. The Applicant surprisingly found that when the fatty acid had 8 to 10 carbon atoms and the monoester was less than 60 mole percent rather than greater than 60% by weight, the composition was storage stable. This result is clearly unobvious.

The foregoing consideration, it is respectfully submitted that the prior art rejection should be withdrawn.

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Respectfully submitted,

By Edward A. Meilman

Edward A. Meilman

Registration No.: 24,735

DICKSTEIN SHAPIRO LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 277-6500

Attorney for Applicant